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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,674	11/21/2003	Hiroyuki Sakuyama	245673US2	9064
22850	7590	10/18/2007		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER DANG, DUY M	
			ART UNIT	PAPER NUMBER
			2624	
			NOTIFICATION DATE	DELIVERY MODE
			10/18/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/717,674	SAKUYAMA ET AL.	
	Examiner	Art Unit	
	Duy M. Dang	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 3-6, 8-17, 20-23 and 25-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 18, 19 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/23/04 + 4/20/04 + 2/8/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of Species I, claims 2 and 19 in the reply filed on July 26, 2007 is acknowledged. The traversal is on the ground(s) that "search and examination of the entire application would not place a serious burden on the examiner" (see page 1 last 4 line of the reply filed on July 26, 2007). This is not found persuasive because of the following reasons.

-It is noted that "*Restriction is a practice of requiring an application to elect a single claimed invention (e.g., a combination or subcombination invention, a product or process invention, a species within a genus) for examination when two or more independent inventions and/or two or more distinct inventions are claimed in an application.*" See MPEP 802.02.

Furthermore, "*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*" See 35 USC § 101. In this case, the instant application does not contain a single claimed invention, thus applicant is required to elect a single claimed invention.

-Search and examination is different from each species. For example, search for species 2-4 does not require to search for "extracting unit" in claims 2 and 19 of species 1; search for species 1, and 3-4 does not require to search for "the additional information stored by said storing unit is different from additional information included in the compressed and coded data" in claims 3-5 and 20-22 of species 2; search for species 1-2 and 4 does not require to search for "adding unit" in claims 6 and 23 of species 3; and search for species 1-3 does not require to search for "COM marker, JPEG format, BOX, IPR, UUID, and XML" for claims 8-17 and 25-34

Art Unit: 2624

of species 4. Thus, there is a serious burden for search and examination for the instant application.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 3-6, 8-17, 20-23, and 25-34 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species 2-4, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 26, 2007.

Information Disclosure Statement

3. The information disclosure statement filed 2/23/04 and 2/8/05 include some documents which have been made of record by not considered by examiner because they are either duplicated or the instant application itself.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 2624

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa et al., referred as Nishikawa hereinafter (USPN 6,246,438.).

Regarding claim 1, Nishikawa teaches an apparatus for coding and decoding (see figures 1 and 5-6 each comprises coder and decoder depicted at 40 and 50 respectively), comprising: a decoding unit which decodes compressed and coded data to restore original image data (decoder 50 of figures 1 and 5-6. Also analyzer depicted at 310 in each of figures 1 and 5-6 functions as the so called "decoding unit" according to figures 13-14 and column 10 lines 45-62); a storing unit which stores additional information other than the image data in memory (see memory depicted at 315 and 328 of figure 13); and a coding unit which encodes at least a portion of the additional information stored in said memory as information additional to the image data when performing second-time encoding of the image data decoded by said decoding unit (see re-encoding apparatus 30 of figures 1 and 5-6 comprising synthesizer 320 which functions as a second-time encoding and generates coded data 240).

Regarding claim 2, The apparatus as claimed in claim 1, further comprising an additional information extracting unit which extracts the additional information from the compressed and coded data when the compressed and coded data is decoded (see 350 of figure 6), and said storing unit stores the additional information extracted by said additional information extracting unit in said memory (see memory 315 and 328 of figure 13).

Regarding claim 7, The apparatus as claimed in claim 1, further comprising a selection unit which selects whether to encode the additional information when said coding unit performs

Art Unit: 2624

the second-time encoding (see searcher 329 and subtractor 330 of figure 13. Each or both refer to selection unit).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18-19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa.

The advanced statements with regard to Nishikawa as applied to claims 1-2 and 7 in the preceding paragraph 6 are incorporated herein. It is noted that claims 18-19 and 24 recite a computer readable record medium having a program embodied therein for carrying out the claimed invention as called for in apparatus claims 1-2 and 7. While Nishikawa discloses coder and decoder as pointed out in the 102 rejection above, Nishikawa does not explicitly teach the use of such medium having a program embodied therein. However, it is well known in the art (Official Notice) to use such medium having a program embodied therein for coding and decoding because program or software is simple, cheap, and easier to modify and/or tailor.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use such medium having a program embodied therein in combination with Nishikawa for that reasons.

Art Unit: 2624

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Examples of such coder and decoder are cited in the PTO-892 attached.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 6:00AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dmd
10/07


DUY M. DANG
PRIMARY EXAMINER